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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,242	01/19/2005	Eleanor Bernice Ridley	HP/15-22715/A/MA 2224/PCT	6482
324 7590 04/11/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER ROGERS, JAMES WILLIAM	
			ART UNIT	PAPER NUMBER
			1618	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/11/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/523,242

Applicant(s)

RIDLEY ET AL.

Examiner

James W. Rogers, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

The amendments to the claims filed 3/2/2007 have been entered. The examiner notes that claim 1 has been amended to exclude R<sub>7</sub> from the proviso that at least one of the substituents R<sub>6</sub>, R<sub>7</sub>, R<sub>8</sub> and R<sub>9</sub> is C<sub>1</sub>-C<sub>4</sub> alkyl; also R<sub>7</sub> no longer reads on C<sub>2</sub>-C<sub>4</sub> alkyl. The examiner has deemed that no new matter exists in the amended claims because applicants have simply excluded a part of what was previously claimed. See MPEP 2173.05(i) Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reasons set forth in the previous office action dated 03/02/2007.

Applicants arguments/remarks filed 03/02/2007 have been fully considered but are not persuasive.

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Applicants asserts that the previous 112 second paragraph rejection is addressed and overcome because the term "emulsion" has been entered before the word polymerization.

The relevance of this assertion is unclear. While the examiner appreciates limiting the process to make the copolymer the rejection was based on the fact that the type of copolymer claimed is ambiguous. Therefore the previous rejection still stands because as described below and in the previous office action the meets and bounds as to what type of copolymer is encompassed is indefinite. A copy of the original rejection of claims 1,7 and 9 is below:

Specifically claims 1,7 and 9 each claim a copolymer derived from the polymerization of a, b and c, the meets and bounds of this claim is not clear, for instance what type of copolymer is encompassed by the polymerization, such as a random, block, graft or alternating copolymer. Also as claimed it is not clear if further steps could be encompassed within the currently claimed limitation, for instance the claims do not rule out further functionalization or polymerization after the copolymer has formed. For clarity the examiner suggest rewriting the claims to limit the copolymer to the exact type disclosed in the specification, for example a graft copolymer polymerized from a, b and/or c. To expedite the examining process the examiner simply searched for any copolymer comprised of monomers a and b.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Galleguillos et al. (US 6,361,768 B1, cited in search report PCT/EP03/07637 provided by applicants), for the reasons set forth in the previous office action dated 03/02/2007.

Applicants arguments/remarks filed 03/02/2007 have been fully considered but are not persuasive.

Applicants assert that the amendment to the claims limits the claimed copolymer exclusively to those copolymer derived from monomers of formula (I) and (II) and is therefore free of the Galleguillos reference that teaches copolymers comprised of at least three different monomer components.

The examiner respectfully disagrees with this assessment of applicants claimed invention. As currently amended the examiner interprets applicants claim 1 to be drawn to a copolymer, with a product by process type of limitation that the copolymer is derived from the emulsion polymerization of monomers (I) and (II) and optionally a cross-linking agent. As currently claimed the claim does not exclude additional elements from being present in the copolymer such as additional monomers, since the claim language does not preclude the use of additional monomers prior art that teaches a copolymer comprised of monomers (I) and (II) would read on applicants claimed invention. Since the Galleguillose reference teaches copolymers comprised of monomers (I) and (II) the rejection still stands because Galleguillose anticipates

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applicants claimed invention. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 1-2,5-7 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Mita et al. (US 5,278,269, cited in search report PCT/EP03/07637 provided by applicants), for the reasons set forth in the previous office action dated 03/02/2007.

Applicants assert that the amendment limits the claimed copolymer exclusively to those copolymers derived from monomers of formula (I) and (II) and is therefore free of the Mita reference that teaches copolymers comprised of at least three monomer components.

The examiner respectfully disagrees with this assessment of applicants claimed invention. As currently amended the examiner interprets applicants claim 1 to be drawn to a copolymer, with a product by process type of limitation that the copolymer is derived from the emulsion polymerization of monomers (I) and (II) and optionally a cross-linking agent. As currently claimed the claim does not exclude additional elements from being present in the copolymer such as additional monomers, since the claim language does not preclude the use of additional monomers prior art that teaches a

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copolymer comprised of monomers (I) and (II) would read on applicants claimed invention. Since the Mita reference teaches copolymers comprised of monomers (I) and (II) the rejection still stands because Mita anticipates applicants claimed invention.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galleguillos et al. (US 6,361,768 B1, cited in search report PCT/EP03/07637 provided by applicants) and in view of Lentini et al. (US 5,665,368), this new rejection was necessitated by applicants amendments to the claims filed 03/02/2007.

Galleguillos discloses copolymers such as those claimed by applicants containing monomers of formula (I) and (II) were already well known at the time of the invention to be crosslinked and used in cosmetic compositions. Also Galleguillos disclosed the use of 8% propylene glycol (meets limitation of an oil-component) in a hair conditioning formulation, within applicants claimed range in claim 11. See abstract and col 2 lin 58-61.

Lentini is used only for the disclosure that oils were already well known at the time of the invention to be used in a large variety of concentrations in cosmetics depending upon the application, for instance the cosmetics disclosed within Lentini had an oil content of from about 20-80 percent within applicants claimed range for claims 11-12.

It would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to combine the art described in the documents above because Galleguillos disclosed all of applicants claimed invention except for the amount of oil in the cosmetics and Lentini is used only to show that it was well known at the time of the invention that oils in cosmetic compositions could be used in a large variety of



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concentrations depending upon the cosmetic application. The motivation to combine the above documents would be to produce a cosmetic composition comprised of oil and a crosslinked copolymer polymerized from a quaternary ammonium monomer and an acrylamide monomer. The advantage of such a cosmetic would be that by crosslinking the copolymer the skilled artisan could modify and control the properties of the resulting copolymer and the skilled artisan could further modify and control the properties of the cosmetic composition by adjusting the amount of oil in the cosmetic. Thus, the claimed invention, taken as a whole was *prima facie* obvious over the combined teachings of the prior art.

### **Conclusion**

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

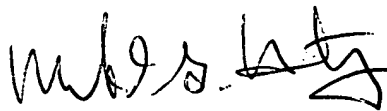
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 572-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Mike Hartley", with a stylized flourish at the end.

MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER